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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,409	02/10/2004	David C. Kelman	10557/296452	2422

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EXAMINER

REIMERS, ANNETTE R

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/776,409

Applicant(s)

KELMAN, DAVID C.

Examiner

Annette R. Reimers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 and 42-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 24-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:12/28/04,3/23/06,5/15/06,12/21/06.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Invention I, claims 1-14 and 24-41, in the reply filed on January 23, 2007 is acknowledged.

Claims 15-23 and 42-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 23, 2007.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-14 and 24-41 are rejected under 35 U.S.C. 101 because they are drawn to non-statutory subject matter. In claim 1, lines 4-5, applicant positively recites part of a human, i.e., "wherein the resorbable device is inserted into a cavity between the implant and the bone tissue of the human or the animal.". In claim 24, lines 3-4, applicant positively recites part of a human, i.e., "wherein the at least one resorbable component is at least partially inserted into the bone tissue." In claim 33, lines 6-7, applicant positively recites part of a human, i.e., "wherein the at least one resorbable component is at least partially inserted into the bone tissue." Thus, claims 1-14 and 24-41 include a human within their scope and are non-statutory.

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A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 24-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Kampner (US Patent Number 5,571,193).

Kampner discloses various embodiments of a system for stabilization of an implant in bone tissue of a human or an animal, comprising a prosthetic implant, e.g. 1A and 1B, and a hybrid resorbable device comprising at least one resorbable component, e.g. 6, and one non-resorbable component, e.g. 8, wherein the resorbable device is inserted into a cavity between the implant and the bone tissue of the human or the animal, and wherein the resorbable device is at least partially resorbed over a predetermined period of time, wherein the resorbable device comprises a resorbable polymer, wherein the resorbable polymer is poly-L-lactic acid, polyglactin acid, or a combination thereof, wherein the resorbable device further comprises calcium sulphate, calcium phosphate or a combination thereof, wherein the resorbable device further comprises a bioactive molecule, wherein the bioactive molecule is a growth factor or

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antibiotic, wherein the resorbable device is a spacer having a predetermined shape that at least partially fills the cavity to reduce movements of the implant relative to the bone, wherein the resorbable device is inserted during a joint replacement surgery, wherein the prosthetic implant is a hip implant, a knee implant, a shoulder implant, or an elbow implant, or a component thereof, wherein the prosthetic implant or the component thereof is inserted into an intramedullary canal of a tubular bone, and wherein the resorbable device is inserted into the cavity between the bone and the prosthetic implant, further comprising an allograft bone, resorbable granules, or a combination thereof, wherein the joint replacement surgery is revision surgery, wherein the implant is a hip replacement comprising a femoral stem, wherein the femoral stem is inserted into the femoral canal, and wherein the resorbable device is inserted into the cavity between a cortex of the femur and the femoral stem of the hip implant, wherein the hybrid resorbable device is a peg, comprising a locking shoulder portion, and a peg portion, and wherein the non-resorbable component is the locking shoulder portion, and the resorbable component is the peg portion, wherein the implant is an acetabular component of a hip implant comprising openings, e.g. 18, and the hybrid resorbable device, e.g. 20, is inserted through the openings into the bone (see figures 1 and column 3, lines 29-36 and column 4, lines 45-57).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Kampner, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kampner (US Patent Number 5,571,193) in view of Eisermann et al. (US Patent Number 6,827,743).

Kampner discloses the claimed invention except an orthopedic cable. Eisermann et al. disclose an orthopedic cable, e.g. 46, and teach the use of a cable to secure the implant to the bone (see figure 8 and column 8, lines 11-13). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Kampner with an orthopedic cable, in view of Eisermann et al., to secure the implant to the bone.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER